

ESTTA Tracking number: **ESTTA470306**

Filing date: **05/02/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054095
Party	Plaintiff Southern Mills, Inc.
Correspondence Address	MICHAEL E ROBINSON LUEDEKA, NEELY & GRAHAM PC PO BOX 1871 KNOXVILLE, TN 37901 UNITED STATES RRobinson@LNG-Patent.com, MBradford@LNG-Patent.com, SHarden@LNG-Patent.com, jlessen@woodcock.com
Submission	Motion to Compel Discovery
Filer's Name	Michael E. Robinson
Filer's e-mail	RRobinson@LNG-Patent.com
Signature	/michael e robinson/
Date	05/02/2012
Attachments	6707199-tottab-20120502-motion_to_compel_re_deposition.pdf (10 pages) (43244 bytes) 6707199-tottab-20120502-declaration_for_motion_to_compel_re_deposition.pdf (4 pages)(40449 bytes) 6707199-exhibit-20120502-30(b)(6) Motion Exhibit A.pdf (8 pages)(55181 bytes) 6707199-exhibit-20120502-30(b)(6) Motion Exhibit B.pdf (7 pages)(51668 bytes) 6707199-exhibit-20120502-30(b)(6) Motion Exhibit C.pdf (6 pages)(253953 bytes) 6707199-exhibit-20120502-30(b)(6) Motion Exhibit D.pdf (36 pages)(432902 bytes)

)	
)	PETITION FOR
SOUTHERN MILLS, INC.)	CANCELLATION
DBA TenCate Protective Fabrics USA)	
Petitioner)	Cancellation No. 92054095
)	Registration No. 3,915,295
)	Supplemental Register
vs.)	
)	Date of Issue: Feb. 1, 2011
)	
DRIFIRE, LLC)	
Respondent)	
)	

MOTION TO COMPEL DESIGNATION OF FRCP 30(B)(6) WITNESS(ES) AND
PROVIDE ALTERNATIVE DATE(S), TIME, AND/OR PLACE FOR HOLDING
DISCOVERY DEPOSITION

1

I. Summary of Facts

On June 10, 2011, Petitioner filed a Petition for Cancellation of the mark COMFORTABLE FR WEAR registered on the supplemental register by Respondent. Based on the original scheduling order issued by the Board, the discovery period was scheduled to open on August 22, 2011 and close on February 18, 2012. The parties held an initial discovery conference during the week of August 15, 2011, in which it was agreed that no major changes would be made to the initial discovery rules and in which a follow up conference was scheduled for September 2, 2011.

A. Facts Regarding the Notice of Discovery Deposition Served On February 6, 2012

On November 29, 2011, counsel for Petitioner wrote counsel for Respondent requesting that Respondent determine which person(s) would be acting as a 30(b)(6) witness for DriFire. No response was received. On February 6, 2012, a Notice of Discovery Deposition of Respondent under Trademark Rule 2.120 and Rule 30(b)(6) of the Federal Rules of Civil Procedure was sent both by electronic mail and U.S. mail to counsel for Respondent. *See* Exhibit A of accompanying declaration by counsel for Petitioner. In its Notice, Petitioner stated that a deposition would take place on March 6, 2012, and offered to take the deposition at the offices of counsel for Respondent. Further, the Notice directed Respondent to designate one or more officers, directors, managing agents, or other persons willing to testify who are most knowledgeable and competent to testify regarding the topics listed in the Notice. The Notice also included a detailed statement regarding the matters upon which testimony would be taken at the deposition. *See* Exhibit A of accompanying declaration by counsel for Petitioner.

After a one month extension of time to respond to Petitioner's first round of written discovery requests was requested by counsel for Respondent and agreed to by Petitioner (which also included a request which was granted by the Board for extending the discovery period by an additional 30 days), the parties later agreed to a further two-month extension of the discovery period, with the new extended discovery period terminating on May 18, 2012 as a result of, *inter alia*, Respondent attempting to arrange acceptable dates for the noticed deposition. In a letter to Respondent attached as Exhibit B and dated February 17, 2012, Petitioner again requested that Respondent provide which person(s) Respondent expected to present to act as 30(b)(6) witness(es) at the deposition scheduled for March 6, 2012. On March 2, 2012—almost one month after receiving the Notice of Discovery Deposition—counsel for Respondent sent counsel for Petitioner an email stating that March 6 would not be an acceptable date for the scheduled deposition and stated that Respondent would provide an acceptable range of proposed dates for the deposition within the following week. *See* Exhibit C of accompanying declaration by counsel for Petitioner. No subsequent information was received the next week though Petitioner, on March 2, 2012, had again requested that Respondent provide acceptable dates for the deposition of Respondent's 30(b)(6) witness(es). As of the date of filing this motion with the Board (May 2, 2012), Respondent still has not provided Petitioner with the identity of its designated 30(b)(6) witness(es), nor has Respondent provided Petitioner with any acceptable date to conduct the noticed deposition.

B. Facts Regarding Written Discovery

Petitioner's First Set of Requests for Documents and Things and Petitioner's First Set of Interrogatories were served on counsel for Respondent on November 1, 2011 via email and U.S. mail. At the request of counsel for Respondent, Petitioner agreed to a one-month extension of

time for Respondent to respond to Petitioner's first round of written discovery and the parties agreed to extend the discovery period by one month with the Board's consent. Respondent's responses to Petitioner's First Set of Requests for Documents and Things and Petitioner's First Set of Interrogatories were sent to counsel for Petitioner on January 5, 2012.

In its responses, Respondent objected to each and every interrogatory and requests for documents and did not provide adequate substantive responses to the interrogatories and requests for documents. Counsel for Petitioner and Respondent exchanged multiple correspondence in an effort to resolve Respondent's objections to the interrogatories and requests. *See* Exhibit D of accompanying declaration by counsel for Petitioner. Counsel for Petitioner sent a letter in response to Respondent's objections on January 13, 2012 addressing Respondent's objections and requesting complete responses to each of the interrogatories and requests for documents. *See* Exhibit D of accompanying declaration by counsel for Petitioner. On January 26, 2012, Petitioner's counsel received a letter from Respondent's counsel in response to Petitioner's letter of January 13, 2012. *See* Exhibit D of accompanying declaration by counsel for Petitioner. In the January 26 letter, Respondent maintained its objections to Petitioner's interrogatories and requests for documents and Respondent refused to provide additional information in response to Petitioner's interrogatories and requests for documents. Counsel for Petitioner then further responded to Respondent's objections in a letter dated February 1, 2012 in an effort to resolve Respondent's objections to the interrogatories and requests for documents. *See* Exhibit D of accompanying declaration by counsel for Petitioner.

During the week of February 6, 2012, counsel for the parties held a phone conference discussing the various interrogatories and requests. Counsel for the parties agreed to a two-month extension to the discovery deadline but were unable to resolve many of Respondent's objections

to the interrogatories and requests for documents. Counsel for Petitioner sent a final letter on February 17, 2012, again attempting to clarify the interrogatories and requests for documents to which Respondent did not respond. *See* Exhibit D of accompanying declaration by counsel for Petitioner.

II. Argument

The notice provided to Respondent in the Notice of Discovery Deposition dated February 6, 2012, was reasonable as required under FRCP 30(b)(1) as it provided specific information on the topics to be covered in the deposition and thirty days advance notice. Counsel for Petitioner has requested on multiple occasions for Respondent to designate one or more officers, directors, managing agents, or other persons willing to testify who are most knowledgeable and competent to testify regarding the topics specifically outlined in the Notice of Discovery Deposition and to suggest alternative dates, times, and/or places for holding such deposition. Examples of these subsequent requests are given above and provided as Exhibit B and Exhibit C. As of May 1, 2012, Respondent has failed to provide a single name or to suggest a single alternate date, place, or time for holding the deposition.

A. Request to Compel Respondent to Provide FRCP 30(b)(6) Witness Information and Provide Alternate Dates, Times, and or Places for Holding the Discovery Deposition of Respondent

Petitioner respectfully asserts that the delay by Respondent in designating persons to be deposed on behalf of Respondent under FRCP Rule 30(b)(6) and to provide alternate dates, places, and/or times for such deposition is an attempt to delay the discovery process so that Petitioner is left with little or no time to conduct follow-up discovery after such deposition. Currently, the discovery period is set to expire on May 18, 2012.

Petitioner has not sat idly by during the discovery period. Rather, Petitioner moved first (and early) to attempt to obtain written discovery from Respondent and then to set up one or more depositions. As the Board is well aware, it is helpful to have written discovery responses available prior to taking the deposition of an adverse witness. *See, e.g.,* Handelman, Jeffrey A., GUIDE TO TTAB PRACTICE, § 12.09[D] (“The better practice . . . is to serve a document request under Rule 34 well in advance of the discovery deposition . . . to maximize[e] the effectiveness of the deposition.”). As the record shows, Petitioner was lenient in allowing for extensions of time, and the need for these extensions was based primarily on Respondent’s delay in providing meaningful responses to initial written discovery requests sent via electronic mail and U.S. mail to counsel for Respondent on November 1, 2011.

Respondent has benefitted from a two-month extension to attempt to provide a range of acceptable dates for the deposition but has failed to provide any acceptable dates. Petitioner is entitled to obtain oral testimony, as well as written responses, with respect to subject matter which is discoverable under FRCP 26(b)(1). Petitioner reasonably believes important information will be garnered from such deposition which will open new and potentially unknown avenues of discovery. However, Petitioner cannot force Respondent to provide names and alternate dates for such deposition. With no other alternative, Petitioner has taken this step to involve the Board and hereby requests that the Board compel Respondent to move forward with the discovery process by (1) designating one or more officers, directors, managing agents, or other persons willing to testify who are most knowledgeable and competent to testify regarding the topics specifically outlined in the Notice of Deposition sent on February 6, 2012, and (2) to provide alternate dates (and/or location(s)) to have such deposition.

B. Request to Extend the Discovery Period By 60 Days to Minimize the Adverse Impact of Respondent's Delay In Providing FRCP 30(b)(6) Witness Information and Provide Alternate Dates, Times, and or Places for Holding the Discovery Deposition of Respondent

In order to minimize the adverse impact on Petitioner by the delay of Respondent in responding to the Notice of Deposition sent February 6, 2012, to Respondent's counsel, Petitioner hereby moves the Board to extend the discovery period in this case by an additional 60 days during which time Petitioner will have a fair opportunity to conduct follow-up discovery after such deposition is held. (This request for an additional 60 days of the discovery period is without regard to any temporary stay of proceedings implemented by the Board while the merits of this motion are under review.) Petitioner believes the request for extending the discovery period by an additional 60 days to be reasonable and that adequate good cause as required under Trademark Rule 2.116(a) has been demonstrated by, *inter alia*, the specific facts discussed above relating to Respondent's refusal to designate persons under FRCP 30(b)(6) to testify at the requested deposition or provide alternative dates, times, and/or locations to hold such deposition, wherein such delay has extended from March 6, 2012, until now, May 1, 2012 (*i.e.*, approximately 60 days).

Here, Petitioner has not delayed in initiating the discovery process in carrying its burden of moving forward with such discovery as demonstrated by the facts recited above. Rather, Petitioner's efforts to keep things moving in the discovery process have been stymied by, *inter alia*, Respondent's unwillingness to provide basic information in a timely manner in response to Petitioner's Notice of Discovery Deposition dated February 6, 2012, and to work with Petitioner

in getting a deposition scheduled. As such, Petitioner respectfully requests that the Board adjust the discovery schedule as outlined below as follows:

Deadline for Discovery Conference: CLOSED

Discovery Opens: CLOSED

Initial Disclosures Due: CLOSED

Expert Disclosure Due: CLOSED

Discovery Closes: 07/17/2012

Plaintiff's Pretrial Disclosures: 08/31/2012

Plaintiff's 30-day Trial Period Ends: 10/15/2012

Defendant's Pretrial Disclosures: 10/30/2012

Defendant's 30-day Trial Period Ends: 12/14/2012

Plaintiff's Rebuttal Disclosures: 12/29/2012

Plaintiff's 15-day Rebuttal Period Ends: 01/28/2013

III. Conclusion

For all of the foregoing reasons, Petitioner respectfully requests that the Board enter an order directing Respondent to designate one or more officers, directors, managing agents, or other persons willing to testify who are most knowledgeable and competent to testify regarding the topics specifically outlined in the Notice of Deposition as shown in Exhibit A and to provide alternate dates, times, and/or locations to have such deposition within ten days of the issuance of such an order. Additionally, Petitioner respectfully requests that the Board extend the close of discovery deadline by an additional 60 days due to delay caused by Respondent's failure to respond to Petitioner's Notice of Deposition in a timely manner.

Attorneys for Petitioner, pursuant to Trademark Rule 2.120(e)(1), have made a good faith effort over almost a three month period by conference and correspondence to resolve the issue of Respondent's unwillingness to respond to Petitioner's Notice of Discovery Deposition dated February 6, 2012, with a designation of one or more officers, directors, managing agents, or other persons willing to testify who are most knowledgeable and competent to testify regarding the topics specifically outlined in the Notice of Deposition or provide alternate dates, times, and/or locations to have such deposition. As such, Petitioner respectfully requests the Board to grant this motion to move this case forward.

Respectfully submitted,

LUEDEKA NEELY GROUP, P.C.
Attorneys for Petitioner

Dated: May 2, 2012

By: Michael E. Robinson
Michael E. Robinson, Reg. No. 58,947
Michael J. Bradford, Reg. No. 52,646
Luedeka Neely Group, P.C.
P.O. Box 1871
Knoxville, TN 37901
(865) 546-4305
RRobinson@LNG-Patent.com
MBradford@LNG-Patent.com

CERTIFICATE OF SERVICE

I, Michael E. Robinson, hereby certify that on May 2, 2012, I caused a true and correct copy of the within Motion To Compel Designation Of FRCP 30(B)(6) Witness(es) And Provide Alternative Date(s), Time, and/or Place For Holding Discovery Deposition to be served by means of U.S. Mail and Electronic mail on the following counsel:

Charlie C. Lyu, Esq.
Woodcock Washburn LLP
Cira Center, 12th Floor
2929 Arch Street
Philadelphia, Pennsylvania 19104
CLyu@woodcock.com

Dated: May 2, 2012

By: Michael E. Robinson
Michael E. Robinson

)	
)	PETITION FOR
SOUTHERN MILLS, INC.)	CANCELLATION
DBA TenCate Protective Fabrics USA)	
Petitioner)	Cancellation No. 92054095
)	Registration No. 3,915,295
)	Supplemental Register
vs.)	
)	Date of Issue: Feb. 1, 2011
)	
DRIFIRE, LLC)	
Respondent)	
)	

DECLARATION OF MICHAEL E. ROBINSON
IN SUPPORT OF PETITIONER'S MOTION TO COMPEL

1. I am a member of the law firm Luedeka Neely Group, P.C., counsel for petitioner Southern Mills, Inc. (“Southern Mills”) in this matter. I submit this declaration in support of Southern Mills’ Motion to Compel DriFire, LLC, the Respondent in this matter, to designate FRCP 30(b)(6) witness(es) and provide alternative date(s), time, and/or place for holding a discovery deposition. I have personal knowledge of the facts set forth in this declaration, which encloses the evidence referenced in Southern Mills’ Motion to Compel.

2. On November 29, 2011, I personally wrote counsel for Respondent requesting that Respondent determine which person(s) would be acting as a 30(b)(6) witness for DriFire, but no substantive response was received.

3. A one month extension of time to respond to Petitioner's first round of written discovery requests was requested by counsel for Respondent and agreed to by Petitioner (which also included a request which was granted by the Board for extending the discovery period by an additional 30 days).

4. The parties later agreed to a further two-month extension of the discovery period, with the new extended discovery period terminating on May 18, 2012 as a result of, *inter alia*, Respondent attempting to arrange acceptable dates for the noticed deposition.

5. I have attached, as Exhibit A, a true copy of Petitioner's Notice of Discovery Deposition of Respondent Pursuant to Fed. R. Civ. P. 30(b)(6) which was served on counsel for Respondent on January 6, 2012 by electronic mail and U.S. Mail.

6. I have attached, as Exhibit B, a true copy of a letter sent to counsel for Respondent on February 17, 2012, in which Southern Mills requested that counsel for Respondent provide the identity of their witness(es) for the 30(b)(6) deposition.

7. I have attached, as Exhibit C, true copies of a letter and email from counsel for Respondent in which Respondent stated they would provide acceptable dates for the 30(b)(6) deposition the following week.

8. No subsequent information was received from counsel for Respondent the next week though Petitioner, on March 2, 2012, had again requested that Respondent provide acceptable dates for the deposition of Respondent's 30(b)(6) witness(es).

9. As of the date of filing this motion with the Board, Respondent still has not provided Petitioner with the identity of its designated 30(b)(6) witness(es), nor has Respondent provided Petitioner with any acceptable date to conduct the noticed deposition.

10. Petitioner's First Set of Requests for Documents and Things and Petitioner's First Set of Interrogatories were served on counsel for Respondent on November 1, 2011 via email and U.S. mail.

11. Respondent's responses to Petitioner's First Set of Requests for Documents and Things and Petitioner's First Set of Interrogatories were sent to counsel for Petitioner on January 5, 2012.

12. In its responses, Respondent objected to each and every interrogatory and requests for documents and did not provide adequate substantive responses to the interrogatories and requests for documents.

13. Counsel for Petitioner and Respondent exchanged multiple correspondence in an effort to resolve Respondent's objections to the interrogatories and requests. I have attached, as Exhibit D, true copies of letters between counsel for Petitioner and counsel for Respondent in which Petitioner attempted to resolve Respondent's objections to written discovery served on Respondent.

14. During the week of February 6, 2012, counsel for the parties held a phone conference discussing the various interrogatories and requests.

15. During the phone conference referred to in item 14, Counsel for the parties agreed to a two-month extension to the discovery deadline but were unable to resolve many of Respondent's objections to the interrogatories and requests for documents.

I declare under penalty of perjury that the foregoing is true and correct.

Dated: May 2, 2012

By: Michael E. Robinson
Michael E. Robinson, Reg. No. 58,947
Luedeka Neely Group, P.C.
P.O. Box 1871
Knoxville, TN 37901
(865) 546-4305
RRobinson@LNG-Patent.com

CERTIFICATE OF SERVICE

I, Michael E. Robinson, hereby certify that on May 2, 2012, I caused a true and correct copy of the within Declaration and accompanying exhibits thereto to be served by means of U.S.

Mail and Electronic mail on the following counsel:

Charlie C. Lyu, Esq.
Woodcock Washburn LLP
Cira Center, 12th Floor
2929 Arch Street
Philadelphia, Pennsylvania 19104
CLyu@woodcock.com

Dated: May 2, 2012

By: Michael E. Robinson
Michael E. Robinson

EXHIBIT A

ANDREW S. NEELY
ROBERT O. FOX
DAVID E. LAROSE
GEOFFREY D. KRESSIN
AUGUST E. ROEHRIG, JR.
RICHARD W. BARNES, JR.
MARK P. CROCKETT
J. DAVID GONCE
MICHAEL J. BRADFORD
MICHAEL E. ROBINSON
WADE R. ORR
STEPHEN D. ADAMS
MATTHEW M. GOOGE

JAMES R. PALMER
PATENT AGENT

FRED THOMSEN
OF COUNSEL



LUEDEKA
NEELY
GROUP, P.C.

ATTORNEYS AT LAW

INTELLECTUAL PROPERTY MATTERS
PATENTS, TRADEMARKS,
TECHNOLOGY LICENSING, COPYRIGHTS,
AND RELATED MATTERS

February 6, 2012
RRobinson@LNG-Patent.com

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KNOXVILLE, TN 37901

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KNOXVILLE, TN 37902

OAK RIDGE OFFICE:
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1020 COMMERCE PARK DR.
OAK RIDGE, TN 37830

PHONE: (865) 546-4305
FAX: (865) 523-4478
WWW.LNG-PATENT.COM

Mr. Charlie C. Lyu, Esq.
WOODCOCK WASHBURN LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104

Via U. S. Mail followed by E-mail

RE: Petition to Cancel COMFORTABLE FR WEAR, Reg. No. 3,915,295
Cancellation No. 92054095
LNG File No. 67071.99 / C-6664.0

Dear Mr. Lyu:

Please see the enclosed Notice of Discovery Deposition pursuant to Federal Rules of Civil Procedure Rule 30(b)(6) and Trademark Rule 2.120. If you have any questions or would like to adjust the schedule, please give me a call or send an e-mail at your earliest convenience.

Very truly yours,

LUEDEKA, NEELY & GRAHAM, P.C.

By: 
Michael E. Robinson

MER:MMG:nsw

cc: Robert O. Fox, Esq. (*via e-mail*)
Michael J. Bradford, Esq. (*via Email*)
Matthew M. Googe, Esq. (*via Email*)
Lori K. Dunham, Paralegal (*via Email*)
Denise Mroz, Esq. (*via Email*)
Jacqueline Lesser, Esq. (*via Email*)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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)	PETITION FOR
SOUTHERN MILLS, INC.)	CANCELLATION
DBA TenCate Protective Fabrics, USA)	
Petitioner)	Cancellation No. 92054095
)	Registration No. 3,915,295
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vs.)	
)	Date of Issue: Feb. 1, 2011
)	
DRIFIRE, LLC)	
Respondent)	
)	

PETITIONER’S NOTICE OF DISCOVERY DEPOSITION OF RESPONDENT
PURSUANT TO FED. R. CIV. P. 30(b)(6)

Please take notice that, pursuant to Trademark Rule 2.120 and Rule 30(b)(6) of the Federal Rules of Civil Procedure, Petitioner, Southern Mills, Inc. (hereinafter, “Petitioner”), by its attorneys, will take the deposition upon oral examination of Respondent, DriFire, LLC (hereinafter, “Respondent”), on March 6, 2012 at 9:30 a.m. at the Offices of Woodcock Washburn LLP, Cira Centre, 12th Floor, 2929 Arch Street, Philadelphia, Pennsylvania, 19104, or such other time and place as may be agreed by the parties.

Pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure, Respondent is directed to designate one or more officers, directors, managing agents, or other persons willing to testify who are most knowledgeable and competent to testify regarding the topics listed below so as to bind Respondent in reference thereto. It is requested that Respondent promptly identify in writing (including e-mail) the person or persons so designated and for each person so designated, the matter or matters referred to above on which such person will testify.

The deposition shall take place before a certified court reporter authorized by law to take testimony and shall continue until completed. You are invited to attend and conduct only such examination and other activities, if any, as may be permitted by law.

DEFINITIONS

As used herein:

1. All terms not expressly defined within this Definitions section are to be given their ordinary and common meaning.

2. The term “Respondent” refers to and includes DriFire, LLC and any and all companies, corporations, partnerships or other business entities which DriFire, LLC owns, in whole or in part, or to any degree, directly or indirectly, controls or is controlled by DriFire, LLC, including any and all past or present parent, subsidiary, sister, predecessor, or successor companies, corporations, partnerships, or other business entities, or any affiliates, divisions, or units thereof, and all directors, officers, agents, employees, partners, and attorneys of any of the aforesaid, including all persons acting or purporting to act on behalf of or who are, were, or have been subject to the direction and control of any of the foregoing.

3. The term “Petitioner” refers to and includes the above-named Southern Mills, Inc. and any and all companies, corporations, partnerships or other business entities which Southern Mills, Inc. owns, in whole or in part, or to any degree, directly or indirectly, controls or is controlled by Southern Mills, Inc., including any and all past or present parent, subsidiary, sister, predecessor, or successor companies, corporations, partnerships, or other business entities, or any affiliates, divisions, or units thereof, and all directors, officers, agents, employees, partners, and attorneys of any of the aforesaid, including all persons acting or purporting to act on behalf of or who are, were, or have been subject to the direction and control of any of the foregoing.

4. The term “Mark” refers to and includes any and all trademarks, service marks, names, letters, words, and/or other symbols or subject matter, whether registered or not, which indicate, are used to indicate, or are asserted or believed to indicate, designate, and/or refer to the source or origin of any good or service, including, but not limited to, all subject matter which meets the definition of “mark” in 15 U.S.C. § 1127, if any.

5. The term “Name” refers to and includes any and all words, letters, symbols, or other subject matter which identify or are used or are alleged or believed to be used to identify or to refer to any good, service, person, business, activity, or thing and which are not or are contended or believed to not meet the definition of a “Mark.”

6. The terminology “Respondent’s Mark” refers to and includes the Mark of U.S. Trademark Registration No. 3,915,295 (Supplemental Register) for the goods/services described therein and any/all Names or Marks substantially similar thereto.

7. The connectives “and” and “or” shall be construed to include all disjunctive or conjunctive uses or senses thereof as may be necessary to bring within the scope of the subject matter area all information that might, if construed otherwise, be considered as outside of its scope.

Matters Upon Which Testimony Will Be Required

1. Each of Respondent's Marks and all goods and services for which each such Mark has been used and the time period and geographic area of use of each such Mark.

2. The date, place, and circumstances of first use of each of Respondent's Marks anywhere and in commerce for every good and service for which it has been used, and all evidence alleged to prove such first use.

3. The extent and manner of use of Respondent's Marks by Respondent and any/all other persons or entities.

4. The extent and manner of use of Respondent's Marks by Respondent and any/all other persons or entities for any FR fabric and FR wear-related services or goods and the dates and geographic areas of use of the Marks for all such services and goods.

5. The extent and manner in which Respondent and any/all other persons or entities currently and/or in the past have marketed, promoted, and/or sold its/their services and/or goods using or under Respondent's Marks and the dates and geographic areas of such marketing, promotion, advertising, and/or other similar use.

6. The date and circumstances of selection and adoption of each of Respondent's Marks including, without limitation, all reasons why the particular term or terms in such Marks were selected and adopted, all persons involved with selection and adoption of the terms, and all evidence alleged to prove the date on which such terms are alleged to first have been associated with Respondent.

7. All persons and/or entities, past and/or present, believed by Respondent to be known, identified by and/or associated with a Mark or Name including the letter string "comfortable," alone or together with other words, terms, letters, symbols, or subject matter, which Respondent believes to be a unique identifier of a source of services or goods offered for sale, sold or otherwise manufactured by Respondent.

8. All persons or entities, other than Respondent, known to Respondent to be identified by a Mark or Name including the letter string "comfortable," alone or together with other words, terms, letters, symbols, or subject matter.

9. The circumstances relating to Respondent's first knowledge of use of any Mark or Name containing the term "comfortable" by any other person or entity.

10. Any and all agreements, assignments, licenses, consents, distributorship arrangements and/or any other contracts or understandings of any kind relating to and/or referring to any of Respondent's Marks or any other Mark or Name including the term "comfortable" or "comfort".

11. Policies or changes in policies or procedures regarding or related to Respondent's enforcement of marks owned by, used by, and/or licensed by Respondent including, but not limited to, Marks or Names containing the word "comfortable" or "comfort".

12. Any and all consumer or market surveys, opinion polls, or focus groups of any type relating to any of Respondent's Marks, and/or any other Mark or Name containing the term "comfortable" or "comfort".

13. Any and all objections, threatened litigation, claims, allegations, suits, or legal proceedings involving Respondent or any other person or entity involving any attempt to cause any person or entity (including Respondent or any party adverse to Respondent) to cease, stop, discontinue, abandon, cancel, modify, or alter any use, registration, or attempted registration of any Name or Mark containing the term "comfortable" or "comfort".

14. All of Respondent's allegations in Respondent's July 22, 2011, Answer to Petitioner's Petition for Cancellation of Respondent's Mark.

15. All of Respondent's responses and potential responses to Petitioner's First Set of Interrogatories to Respondent and Petitioner's First Set of Requests for Production of Documents and Things to Respondent.

16. Any and all communications between Respondent and any third-party relating to Petitioner, Respondent's Marks, Respondent's goods, or the instant proceeding.

17. All applications and registrations owned or controlled by Respondent for any of Respondent's Mark, patents assigned to Respondent, or patent applications assigned to Respondent including the prosecution history, if any, of all such applications, registrations, and patents.

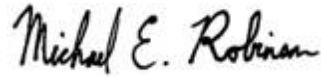
18. To the extent not covered otherwise herein, all third party use of any Mark or Name containing the term "comfortable" or "comfort".

19. All documents pertaining to any of the foregoing subject matter areas.

Respectfully submitted,

SOUTHERN MILLS, INC.

By:

A handwritten signature in black ink that reads "Michael E. Robinson". The signature is written in a cursive style with a large, stylized 'M' and 'R'.

Michael E. Robinson, Reg. No. 58,947

Michael J. Bradford, Reg. No. 52,646

LUEDEKA NEELY GROUP, P.C.

P.O. Box 1871

Knoxville, TN 37901

(865) 546-4305

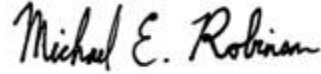
RRobinson@LNG-Patent.com

MBradford@LNG-Patent.com

Date: 02/06/2012_____

CERTIFICATE OF SERVICE

It is hereby certified pursuant to Trademark Rule 2.119 that a true copy of the foregoing Notice of Deposition was sent via U.S. First Class Mail, this 6th day of February, 2012, to Charlie C. Lyu, the attorney for the Petitioner.

A handwritten signature in black ink that reads "Michael E. Robinson". The signature is written in a cursive style with a large, stylized "M" and "R".

Michael E. Robinson

Exhibit B

ANDREW S. NEELY
ROBERT O. FOX
DAVID E. LAROSE
GEOFFREY D. KRESSIN
AUGUST E. ROEHRIG, JR.
RICHARD W. BARNES, JR.
MARK P. CROCKETT
J. DAVID GONCE
MICHAEL J. BRADFORD
MICHAEL E. ROBINSON
WADE R. ORR
STEPHEN D. ADAMS
MATTHEW M. GOOGE

JAMES R. PALMER
PATENT AGENT

FRED THOMSEN
OF COUNSEL



ATTORNEYS AT LAW

INTELLECTUAL PROPERTY MATTERS
PATENTS, TRADEMARKS,
TECHNOLOGY LICENSING, COPYRIGHTS,
AND RELATED LITIGATION

February 17, 2012
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Ms. Jacqueline Lesser, Esq.
WOODCOCK WASHBURN LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104

Via Email Followed By U. S. Mail

RE: Petition to Cancel COMFORTABLE FR WEAR, Reg. No. 3,915,295
Cancellation No. 92054095
LNG File No. 67071.99 / C-6664.0

Dear Ms. Lesser:

This letter is to summarize some of the issues discussed during our phone conference last week.

The parties have agreed to a two-month extension and we note that an order was granted earlier this week allowing for that extension. Thank you for taking care of filing the request. Along the same lines, our client requests a 30-day extension to respond to the discovery propounded by your client that is coming due soon. The extra time will allow our client to consider the documents and answers provided by your client as well as documents provided by third parties under various subpoenas *duces tecum*. Also, as DriFire is aware, this is a busy season for marketing and trade shows. As such, much of the marketing department at Southern Mills is very busy with those efforts right now and they have less time to devote to thoroughly answering DriFire's discovery requests. Please advise if a 30-day extension is acceptable to your client. As you will recall, a one-month extension for your client was previously agreed to by our client vis-à-vis our client's propounded discovery requests.

We are in receipt of the documents you mentioned during the phone conference that were in transit. Thank you for providing these documents.

At your earliest convenience, please let us know who you expect to be present to act as the 30(b)(6) witness(es) at the deposition noticed in our recent Notice of Deposition to DriFire. Also, please let us know when you expect to have a privilege log available for us to review regarding any documents and things that were not included in those that were sent to us.

I. Issues of Concern

During our discussion with regards to interrogatory number 16, you noted that OPTIMER, INC. (“Optimer”) is not the parent company of DriFire, LLC. You indicated that Optimer is in a licensing relationship of some kind with DriFire. We reminded you that Optimer was first disclosed to us in DriFire’s initial disclosures. We also noted during the phone conference that parties in a TTAB action are required to respond to interrogatories to the extent such interrogatories are not properly objected to. You indicated that such rule is permissive and included the term “may,” not “must.” However, TBMP § 405.04(b), citing FRCP Rule 33(b)(3), states that “[e]ach interrogatory *must*, to the extent it is not objected to, be answered separately and fully in writing under oath” (emphasis added). Accordingly, please at least provide a substantive response concerning DriFire’s relationship with Optimer, Inc. and Optimer Performance Fibers, Inc. as soon as possible.

You also argued that license agreements and related information are not relevant to this case (*e.g.*, Request No. 22). However, TBMP § 414(10) states that “[i]nformation concerning litigation controversies including settlement and other contractual agreements made between a responding party and third parties based on the responding party's mark is discoverable.” *See, e.g., Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975) (“[I]nformation pertaining to opposer's contacts with third parties, as through litigation or written or oral agreements, based on opposer's pleaded mark “BAND-AID” for the goods shown in the registration thereof may have some relevance herein, inasmuch as it might tend to show limitations on opposer's rights or inconsistencies with opposer's statements in this proceeding, and that interrogatories seeking such information should accordingly be answered.”). For this and many other reasons, licensing agreements and the specific nature of the relationship between DriFire and any of the parties mentioned in Interrogatory No. 16 is relevant and should be

produced, and any documents and things under Request No. 22 are relevant and should be produced.

We respectfully assert that it is not Petitioner's counsel's job to prove to Respondent's counsel why certain interrogatories and requests propounded by Petitioner for documents and things should be substantively responded to by Respondent. Such a requirement would create an atmosphere in which modern discovery tools would be rendered virtually meaningless for the propounding party. The burden here is on Respondent to demonstrate a reasonable basis for its objections to any interrogatories or requests to produce documents and things. Therefore, Petitioner respectfully requests that Respondent fully respond to any and all remaining interrogatories and requests.

II. Issues for Clarification

A. Petitioner's Interrogatories

Regarding Interrogatory No. 3, Petitioner is entitled to know (and Respondent is required to demonstrate) the identity of Respondent's first customer of goods that were sold using the Mark and the factual circumstances of such first sale in order to verify Respondent's alleged first use date. This is a well known exception to the confidential nature of customer lists generally. See TBMP § 414(3); *Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (stating "a party is usually required to furnish the name and address of its first customer in order to verify its claimed date of first use"). This interrogatory is re-asserted one final time.

Regarding Interrogatory No. 5, the way in which Respondent has used the term "comfortable" and the term "FR wear", and the context of how these terms have been used together and alone is highly significant to a determination of whether the phrase "comfortable FR wear" is generic and has been used in a generic sense by Respondent for the goods provided by Respondent. To the extent necessary, one or more representative lists could be used so long as such list is representative of all uses of the term "comfortable" with respect to the goods offered in conjunction with the Mark by Respondent or Respondent's licensee(s). This interrogatory is re-asserted one final time.

Regarding Interrogatory No. 6, the identity and description of "agreements, assignments, licenses, consents, distributorship arrangements and/or any other contracts or understandings of

any kind between Respondent and any other person relating to and/or referring to Respondent's Mark" is highly relevant. This issue is well-settled as discussed above. *Johnson & Johnson*, 186 USPQ 167. This interrogatory is re-asserted one final time.

Regarding Interrogatory No. 8 and the answer Respondent's counsel has supplied to date, we are made to understand that no searches or investigations were conducted for or relating to Respondent's Mark, and no opinion was provided by or on behalf of Respondent.

Regarding Interrogatory No. 10, please clarify whether Respondent *has ever been* involved in any disputes relating to Respondent's Mark other than the current dispute. This aspect of this interrogatory was not addressed in your previous response. This interrogatory is re-asserted one final time.

Interrogatory No. 15 is hereby revised as follows: "Identify and describe the complete bases upon which Respondent is relying to assert that the phrase 'comfortable FR wear' is capable of distinguishing Respondent's Goods and is not generic to such goods." The term "assert" as used herein in lieu of "claim" is defined using its normal dictionary definition. The basis of the assertion is Respondent's application to register the phrase "comfortable FR wear," wherein Rob Hines signed a declaration under potential penalty of perjury (*i.e.*, "asserting" or "declaring") that DriFire, LLC allegedly has the exclusive right to use such phrase as a source indicator for the goods listed in such application. This interrogatory is re-asserted one final time.

Interrogatory No. 16 is hereby revised as follows: Identify and describe in detail the relationship(s), if any, between DRIFIRE, LLC; OPTIMER, INC.; and OPTIMER PERFORMANCE FIBERS, INC. During our phone conference, you indicated that a licensing relationship exists between DriFire, LLC and Optimer, Inc. and/or Optimer Performance Fibers, Inc. The issue regarding the relevance as to such information is well-settled as discussed above. *Johnson & Johnson*, 186 USPQ 167. This interrogatory is re-asserted one final time.

B. Petitioner's Requests for Documents and Things

Request No. 13 is hereby revised as follows: "All documents concerning market research, product/service development and testing, and business plans concerning Respondent's Respondent's Mark, including without limitation, marketing plans, media plans, sales plans, sales materials, distribution plans and advertising campaigns." This request is focused solely on

Respondent's planned uses for the phrase "comfortable FR wear." This request is re-asserted one final time.

As discussed during the phone conference last week, Petitioner withdraws document requests numbers 14 and 15.

Regarding Request Nos. 19 and 20, evidence of confusion is highly relevant to this case because generic phrases are the most likely of any type of phrase to cause customer confusion. As Respondent's counsel is surely aware, this is true because generic phrases are incapable of operating as a source identifier for goods or services. Thus, such information is very relevant and is likely to lead to other admissible evidence. This request is not overly broad. It is direct and clear. Respondent either has such information or it does not. If Respondent has no such documents and things, please provide a clear response stating such. If Respondent does have such documents and things, Respondent is urged to produce such documents and things immediately. As Respondent's counsel is aware, to the extent any attorney opinion is included in such documentation, such information can be redacted. There is simply no reasonable basis for refusing to provide this information unless no such information exists, in which case Respondent must provide a clear answer stating such to the best of its knowledge. This request is re-asserted one final time.

The benefits to the disclosure of documents and things in response to Request No. 23 outweigh any perceived harm to Respondent because such information will provide direct evidence of the identity of the customers that purchase Respondent's goods, thereby helping to define the purchasing public for this case. This request is re-asserted one final time.

Request No. 26 is hereby revised as follows: "All documents concerning customers' or potential customers' understanding of the meaning of the term 'comfort,' 'comfortable', and 'comfortable FR wear'". This request is re-asserted one final time.

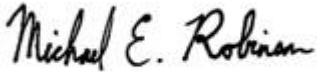
Again, we look forward to a quick, complete, and non-evasive response in order to avoid the need to move to compel this information.

If you have any questions, please give me a call at your earliest convenience. Again, if Respondent is unwilling to provide any further information, responses, documents, and/or things, please let us know at your earliest convenience.

February 17, 2012
Cancellation No. 92054095

Very truly yours,

LUEDEKA NEELY GROUP, P.C.

By: 
Michael E. Robinson

MER:nsw

cc: Robert O. Fox, Esq. (*via e-mail*)
Michael J. Bradford, Esq. (*via e-mail*)
Matthew M. Googe, Esq. (*via e-mail*)
Charlie Lyu, Esq (*via e-mail*)
Denise Mroz, Esq. (*via e-mail*)

Exhibit C

Subject: RE: Notice of Deposition (LNG File No. 67071.99)
Date: Friday, March 2, 2012 5:59:35 PM Eastern Standard Time
From: Lyu, Charlie C. (Woodcock Washburn)
To: Roby E. Robinson, Lesser, Jackie (Woodcock Washburn), Mroz, Denise Incorvaia (Woodcock Washburn)
CC: Michael J. Bradford, Matt Googe, Lori Dunham

Roby,

As we discussed during our telephone conference on February 9, 2012, March 6 will not work for the deposition. That was the basis for extending discovery another 60 days. We are working with our client to determine a range of acceptable dates and hope to have the proposed new dates to you next week.

Attached please find our response to your letter dated February 17, 2012.

Regards,
Charlie

Charlie C. Lyu
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From: Roby E. Robinson [mailto:rrobinson@lng-patent.com]
Sent: Friday, March 02, 2012 11:14 AM
To: Lyu, Charlie C. (Woodcock Washburn); Lesser, Jackie (Woodcock Washburn); Mroz, Denise Incorvaia (Woodcock Washburn)
Cc: Michael J. Bradford; Matt Googe
Subject: Notice of Deposition (LNG File No. 67071.99)

Dear Charlie, Jackie and Denise,

Please let us know at your earliest convenience when and where you plan to have the deposition regarding the Notice of Deposition we served last month on DrFire. I believe the date on the Notice was March 6, 2012 or so, but I assume that date will not be the date the deposition is held considering you previously mentioned moving it back some.

Very truly yours,

Michael E. "Roby" Robinson
Registered Patent Attorney
Luedeka Neely Group, P.C.

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March 2, 2012

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Mr. Michael E. Robinson
Luedeka Neely Group, P.C.
1871 Riverview Tower
900 S. Gay Street
Knoxville, TN 37902

Re: Southern Mills v. DriFire LLC; Cancellation No. 92054095

Dear Roby:

This follows our discussion on February 9th, and your letter of February 17, 2012.

Enclosed with the courtesy copy of this letter, you will find Respondent's privilege log.

You have asked about a new date for the noticed 30 (b) 6 deposition. We are working with our client to determine a range of acceptable dates. The original deposition date of March 16th was not acceptable, as we indicated to you. As your own client knows, March is a busy trade and marketing month in the industry. I hope to have proposed new dates to you in the next week.

The following addresses the points raised in your letter of February 17th, and our telephone call of February 9, 2012.

As discussed during our telephone conference of February 9, 2012, Respondent has agreed to revise its responses to the following Interrogatories.

Interrogatory Response No. 7 to: "Subject to, and without waiver of the objections contained in Respondent's original responses, Respondent has been and is currently the only owner of the mark that is the subject of the registration contested herein."

Interrogatory Response No. 10 is revised to: "Subject to, and without waiver of the objections contained in Respondent's original responses, with the exception of the foregoing dispute with Petitioner, Respondent is not currently, and has not been involved in any disputes relating to Respondent's mark."

Interrogatory Response No. 15 is revised to: "Subject to, and without waiver of the objections contained in Respondent's original responses, Respondent states that it is the only user



Mr. Michael E. Robinson
March 2, 2012
Page 2

of the slogan that it uses as a mark, "COMFORTABLE FR WEAR," Respondent uses its mark, COMFORTABLE FR WEAR on and in connection with the sale and promotion of its products; Respondent identifies the documents it has produced, and continues to produce utilizing its COMFORTABLE FR WEAR mark."

Interrogatory No. 16 has been revised by Petitioner to request the relationship between Optimer, Inc. and DriFire, LLC. Based on the revised, and tailored request (made during the parties' earlier telephone conference), Respondent's response is revised to: "Subject to, and without waiver of the objections contained in Respondent's original responses, DriFire, LLC and Optimer, Inc. are related companies through one or more wholly owned subsidiaries of Sterling Optimer Holdings, LLC. DriFire and Optimer, Inc. jointly license technology."

With respect to the three remaining interrogatories in dispute, Petitioner continues to seek licensing and customer information (see Interrogatory Nos. 3 and 6. The cases cited by Petitioner do not support Petitioner's argument that in an action seeking to cancel a mark on grounds of genericness, the petitioner is entitled to confidential customer and licensee information. Moreover, it seems likely that any list will simply be used for a less than legitimate purpose, calculated to provide Petitioner with confidential customer names to serve document subpoenas on customers (as Petitioner has done with competitors, and retailers, despite the fact that 35 USC 24, does not provide the right to seek document subpoenas in a board proceeding. See also, TBMP 406.01).

Interrogatory No. 5 does not make any sense substantively. Respondent has not claimed a monopoly on the individual words or terms "COMFORTABLE"; "FR" or "WEAR". Indeed, the mark in question is COMFORTABLE FR WEAR. Respondent has provided documents in support of its use of the mark COMFORTABLE FR WEAR and is continuing to produce documents in support of such use.

During our telephone call on February 9, 2012, the parties also discussed particular document requests. Respondent attempted to seek additional clarification on particular document requests.

Petitioner has withdrawn its two document requests which seek confidential sales information. (Requests Nos. 14 and 15). As a point of clarification, Petitioner's counsel mentioned during the telephone call his desire for marketing information – Respondent confirms that none of the existing requests seek marketing figures, and that if Petitioner seeks such information by way of discovery, it will need to make an independent request.



Mr. Michael E. Robinson
March 2, 2012
Page 3

Document Request No. 23 seeks confidential customer lists on the theory that a response will "provide direct evidence of the identity of the customers that purchase Respondent's goods," Respondent has already identified the class of customers who purchase its goods. A confidential customer list is not relevant to the proceeding. Moreover, it seems likely that any list will simply be used for a less than legitimate purpose, calculated to provide Petitioner with confidential customer names to serve document subpoenas on customers (as Petitioner has done with competitors, and retailers, despite the fact that 35 USC 24, does not provide the right to seek document subpoenas in a board proceeding. See also, TBMP 406.01).

Please clarify the changes to Document Request No. 26. The request as initially served on Respondent sought "All documents concerning the concept of comfort vis-à-vis FR wear and the role comfort plays in buyer and user preferences for selecting or wearing particular wear garments." Has Petitioner replaced this request with a request that reads: "All documents concerning customers, or potential customers understanding of the meaning of the term "comfort."? Please confirm or clarify. Additionally, your letter states that "this request is re-asserted one final time." This is the first time that Petitioner has made this request – or substantially changed its earlier request (to our understanding).

Yours sincerely,

A handwritten signature in cursive script that reads "Jacqueline Lesser".

Jacqueline Lesser

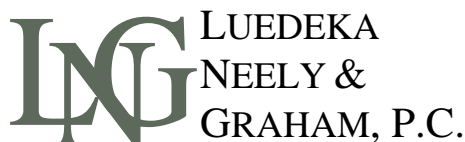
jml

Exhibit D

ANDREW S. NEELY
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DAVID E. LAROSE
GEOFFREY D. KRESSIN
AUGUST E. ROEHRIG, JR.
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Via Email Followed By U. S. Mail

RE: Petition to Cancel COMFORTABLE FR WEAR, Reg. No. 3,915,295
Cancellation No. 92054095
LNG File No. 67071.99 / C-6664.0

Dear Mr. Lyu:

We have reviewed your response to Petitioner's First Set of Interrogatories and Petitioner's First Set of Requests for Production of Documents and Things, and we note several deficiencies as discussed below. This letter represents Petitioner's initial good faith effort to resolve this discovery disagreement pursuant to Trademark Rule 2.120(e).

I. Respondent's Responses to Petitioner's First Set of Interrogatories Are Deficient and Unacceptable

As for the list of general objections given at the beginning of Respondent's Responses to Petitioner's Interrogatories, Petitioner requests that Respondent specifically identify which objections are being attributed by Respondent to which response(s) as required by TBMP § 405.04. Without such specificity, it is impossible to tell which objections are properly attributable to which responses. To generally aver that all of the objections are attributable to all of the responses is improper.

In numerous interrogatories, Petitioner has requested that Respondent “identify” various things including documents. Such interrogatories are not properly rejected based on an assertion of privilege. The identity of such documents or other things is not privileged. TBMP § 402.02. See also *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (party making claims of privilege must do so expressly and otherwise describe the nature of the withheld information as provided in Fed. R. Civ. P. 26(b)(5)). Some of the content of such documents *might* be privileged, however, the identity and nature of the documents for which privilege is claimed must be disclosed.

The following numbered sections correlating to interrogatory number include Petitioner’s comments as to the unacceptable and insufficient nature of Respondent’s responses to Petitioner’s respective interrogatories.

1. The identification and description of goods sold cannot properly be considered information protected by privilege or work product doctrine because they are facts regarding what Respondent or its licensee(s) offer under the Mark (*i.e.*, COMFORTABLE FR WEAR). Confidential or commercially sensitive information can still be made available according to the general protective order.
2. Respondent is in the best position to know the geographic scope of its distribution, sales, marketing, and advertising. This interrogatory is a straightforward request and is not broad (and certainly not harassing) as Respondent has asserted. Respondent states at the end of its response the phrase “other trade sites.” To the extent Respondent is aware or becomes aware of the identity of these so-called “other trade sites,” Petitioner expects that such information be supplemented according to TBMP § 408.03.
3. Petitioner is entitled to know (and Respondent is required to demonstrate) the identity of Respondent’s first customer of goods that were sold using the Mark and the factual circumstances of such first sale in order to verify Respondent’s alleged first use date. This is a well known exception to the confidential nature of customer lists generally. See TBMP § 414(3); *Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (stating “a party is usually required to furnish the

name and address of its first customer in order to verify its claimed date of first use”). Respondent’s response to this interrogatory is a self-serving statement that is unresponsive to the interrogatory.

4. Regarding interrogatories, the identification documents and/or things cannot properly be considered information protected by privilege and/or work product doctrine. Some of the content of such documents and/or things *might* be privileged, but the identification of such documents and/or things is not. Furthermore, to the extent documents and/or things include work product that is properly protectable, the *identification of* such document or things is not so protected. The information sought from this interrogatory is highly relevant to Petitioner’s claims because such evidence demonstrates, *inter alia*, the manner(s) in which Respondent has used the Mark in commerce and whether such use would provide sufficient distinctiveness to do more than identify a particular type of good. To the extent necessary, one or more representative lists could be used so long as such list is representative of *all* uses of Respondent’s mark in commerce. Additionally, Petitioner notes that the time period between which the Mark was allegedly first used by Respondent and the time it was registered on the Supplemental Register was a mere seventeen months—barely more than one year. As such, the alleged “burden” placed on Respondent vis-à-vis this interrogatory appears to be more hyperbole than reality.
5. No substantive response was given by Respondent for interrogatory 5, and this not surprising as interrogatory 5 is perhaps the most relevant of all questions. The way in which Respondent has used the term “comfortable” and the term “FR wear”, and the context of how these terms have been used together and alone is highly significant to a determination of whether the phrase “comfortable FR wear” is generic for the goods provided by Respondent. Respondent is no doubt aware of this. Regarding interrogatories, the identification documents and/or things cannot properly be considered information protected by privilege and/or work product doctrine. Some of the content of such documents and/or things *might* be privileged, but the identification of such documents and/or things is not. Furthermore, to the extent documents and/or things include work product that is properly protectable, the *identification of* such document or

things is not so protected. To the extent necessary, one or more representative lists could be used so long as such list is representative of *all* uses of the term “comfortable” with respect to the goods offered in conjunction with the Mark by Respondent or Respondent’s licensee(s).

6. Regarding interrogatories, the identification documents and/or things cannot properly be considered information protected by privilege and/or work product doctrine. Some of the content of such documents and/or things *might* be privileged, but the identification of such documents and/or things is not. Furthermore, to the extent documents and/or things include work product that is properly protectable, the *identification of* such document or things is not so protected. The information sought from this interrogatory is highly relevant to Petitioner’s claims because such evidence provides information on what persons, if any, have been licensed by Respondent to use the Mark which is likely to lead to, *inter alia*, information on how the Mark has been used by such licensee(s), if any. Respondent is in the best and, perhaps, only position to provide such information, and it would be easy for Respondent to do so.
7. This interrogatory is a simple request for a chain of title of the Mark. Respondent’s response is a self-serving conclusion of law that is non-responsive.
8. Respondent’s response to interrogatory 8 is nonresponsive to what has been requested. Search reports are commonly requested in TTAB proceedings and are discoverable. TBMP § 414(6). If one or more searches was requested or conducted, the fact of the existence of such search and the identity of such document or thing is required to be provided, neither of which are privileged or protected as work product.
9. N/A
10. Respondent has not clarified whether Respondent has ever been involved in any other disputes relating to the Mark. Please clarify this response.

11. Regarding interrogatories, the identification documents and/or things cannot properly be considered information protected by privilege and/or work product doctrine. Some of the content of such documents and/or things *might* be privileged, but the identification of such documents and/or things is not. Respondent's response to interrogatory 11 is effectively nonresponsive as no basis is given for the assertion made by Respondent in its Answer referenced in interrogatory 11. To the extent Petitioner's diction is objected to, Petitioner requests that Respondent explain the difference between the diction used in the original interrogatory 11 and the diction suggested by Respondent. Further, Petitioner asserts this is an apparent attempt to use a semantics argument as a diversion to avoid a substantive response covering the requested factual inquiry.
12. Regarding interrogatories, the identification documents and/or things cannot properly be considered information protected by privilege and/or work product doctrine. Some of the content of such documents and/or things *might* be privileged, but the identification of such documents and/or things is not. Respondent's response to interrogatory 12 is effectively nonresponsive as no basis is given for the assertion made by Respondent in its Answer referenced in interrogatory 12. Respondent is attempting to focus on an alleged lack of evidence which is not the focus of the defense (*i.e.*, the legal claim itself). To the extent Petitioner's diction is objected to, Petitioner requests that Respondent explain the difference between the diction used in the original interrogatory 12 and the diction suggested by Respondent. Further, Petitioner asserts this is an apparent attempt to use a semantics argument as a diversion to avoid a substantive response properly responding to the factual inquiry.
13. Regarding interrogatories, the identification documents and/or things cannot properly be considered information protected by privilege and/or work product doctrine. Some of the content of such documents and/or things *might* be privileged, but the identification of such documents and/or things is not. Respondent's response to interrogatory 13 is effectively nonresponsive as no basis is given for the assertion made by Respondent in its Answer referenced in interrogatory 13. To the extent Petitioner's diction is objected to, Petitioner requests that Respondent explain the difference between the diction used in the

original interrogatory 13 and the diction suggested by Respondent. Further, Petitioner asserts this is an apparent attempt to use a semantics argument as a diversion to avoid a substantive response properly responding to the factual inquiry.

14. Regarding interrogatories, the identification documents and/or things cannot properly be considered information protected by privilege and/or work product doctrine. Some of the content of such documents and/or things *might* be privileged, but the identification of such documents and/or things is not. Respondent's response to interrogatory 14 is effectively nonresponsive as no basis is given for the assertion made by Respondent in its Answer referenced in interrogatory 14. Information is given about alleged attempts by Respondent to influence public perception of the Mark, but nothing is provided as to the public's actual perception of the Mark.
15. Regarding interrogatories, the identification documents and/or things cannot properly be considered information protected by privilege and/or work product doctrine. Some of the content of such documents and/or things *might* be privileged, but the identification of such documents and/or things is not. Respondent's response to interrogatory 15 is effectively nonresponsive as no basis is given for the assertion made by Respondent in its Answer referenced in interrogatory 15. To the extent Petitioner's diction is objected to, Petitioner requests that Respondent explain the difference between the diction used in the original interrogatory 15 and the diction suggested by Respondent. Further, Petitioner asserts this is an apparent attempt to use a semantics argument as a diversion to avoid a substantive response properly responding to the factual inquiry. The term "claim" is two-fold as it refers to Respondent's fourth and fifth affirmative defenses listed in its Answer as well as the signed declaration signed by Rob Hines, vice president of product development, which states that he believes Respondent is "entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either the identical form thereof or in such near resemblance thereto as to be likely, when used in connection with the goods/services of such other person, to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true"—all such statements having been

affirmed by Mr. Hines after having been “warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration.”

16. Regarding interrogatories, the identification documents and/or things cannot properly be considered information protected by privilege and/or work product doctrine. Some of the content of such documents and/or things *might* be privileged, but the identification of such documents and/or things is not.

II. Respondent’s Responses to Petitioners First Set of Requests for Documents and Things Are Deficient and Unacceptable

No privilege log or other indicia of documents alleged to be privileged has been produced. Please provide a privilege log identifying what documents are being withheld and the basis for withholding each document.

Moreover, many relevant documents appear not to have been produced. In fact, to date, no documents have been produced to Petitioner’s counsel in response to Petitioner’s first set of requests for documents and things.

In response to Document Request No. 1 requesting all documents concerning Respondent's responses to "Petitioner's First Set of Interrogatories to Respondent," you responded that such documents are privileged and/or protected by the work product doctrine, are not relevant or reasonably calculated to lead to the discovery of admissible evidence, and that such request is vague and overly broad. Petitioner has attempted to clarify its position(s) with respect to the interrogatories (above) and asserts that neither all such documents (nor all portions of any of such documents) are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, the use of the Mark by Respondent and/or its licensee(s), the business of Respondent, and the allegation(s) of first use of the Mark made by Respondent—all of which are highly relevant to the issue of whether a mark is generic for a

specific group of goods. To the extent necessary, one or more representative samples could be provided so long as such samples are representative of *all* of the documents and things requested. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 2 requesting all documents referring to, relating to, or concerning Petitioner or the goods and services offered by Petitioner, Respondent responded that such documents are privileged and/or protected by the work product doctrine, the expense for the search for such documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 2 (nor all portions of any of such documents) are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, information available to Respondent regarding Petitioner's use of the term "comfortable" with respect to FR wear. To the extent necessary, one or more representative samples could be provided so long as such samples are representative of *all* of the documents and things requested. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided. The issue of the goods offered by Respondent is highly relevant as to determining whether the use of the Mark is a generic use of such phrase because the goods that are sold are the contextual backdrop for such a determination.

In response to Document Request No. 3 requesting all documents concerning, referring to, or relating to the decision to offer and the first offer of Respondent's Goods under Respondent's Mark in commerce, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such request is overly broad and unduly burdensome and the expense for the search for such documents outweighs the importance of such information.. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 3 nor all portions of any of such documents are

privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, information regarding Respondent's first use of the Mark which is highly relevant to the accuracy of Respondent's allegation(s) of first use of the Mark. To the extent necessary, one or more representative samples could be provided so long as such samples are representative of *all* of the documents and things requested. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 4 requesting all documents concerning, referring to, or relating to the selection, creation, adoption, approval, acquisition, development, and/or commencement of use of Respondent's Mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such request is overly broad and unduly burdensome, and the expense for the search for such documents outweighs the importance of such information. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 4 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, information regarding Respondent's first use of the Mark which is highly relevant to the accuracy of Respondent's allegation(s) of first use of the Mark. To the extent necessary, one or more representative samples could be provided so long as such samples are representative of *all* of the documents and things requested. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 5 requesting, *inter alia*, representative documents describing or discussing Respondent's business activities under or using Respondent's Mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence, such request is overly broad and unduly burdensome, and the expense for the search for such documents outweighs the importance of such information. Petitioner has

attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 5 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, information regarding Respondent's business activities conducted in conjunction with respondent's use of the Mark which is highly relevant to the manner and context under which the Mark was presented to the relevant public. To the extent necessary, one or more representative samples could be provided so long as such samples are representative of *all* of the documents and things requested. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 6 requesting, *inter alia*, representative documents identifying each person involved in the selection, creation, adoption, approval, acquisition, development, and/or commencement of use of Respondent's Mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such request is overly broad and unduly burdensome, and the expense for the search for such documents outweighs the importance of such information. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 6 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, specific information regarding persons responsible for the selection and adoption of Respondent's Mark which is likely to reasonably lead to persons that might need to be deposed to provide admissible evidence. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 7 requesting, *inter alia*, all documents concerning, referring to, or relating to any searches or investigations undertaken in connection with the selection, creation, adoption, approval, acquisition, or use of Respondent's Mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such request is overly broad and unduly burdensome, the expense for the search for such

documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 7 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, trademark clearance searches or other similar measures taken prior to or after adoption of the Mark by Respondent—information which is highly relevant and standard in a TTAB proceeding like this one. TBMP § 414(6). This information should be readily available to Respondent and require minimal effort to provide to Petitioner. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 8 requesting, *inter alia*, all documents concerning any trademark application for registration of Respondent's Mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such documents are in the public domain, such request is overly broad and unduly burdensome, the expense for the search for such documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 8 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, documents and things related to any trademark application for registration of Respondent's Mark—primarily, documents and things that are not part of the official record at the USPTO. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 9 requesting, *inter alia*, all documents concerning, referring to, or relating to Respondent's first use of Respondent's Mark for Respondent's Goods, Respondent responded that such documents are privileged and/or protected by the work product

doctrine, such request is cumulative, such request is overly broad and unduly burdensome, the expense for the search for such documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 9 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, documents and things related to Respondent's first use of its mark—information which Petitioner is entitled to obtain to corroborate the accuracy of Respondent's claims of first use of its mark in commerce. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 10 requesting, *inter alia*, representative documents showing Respondent's use of Respondent's Mark for Respondent's Goods for each year since commencement of use of Respondent's Mark by Respondent or its licensee, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such request is overly broad and unduly burdensome, the expense for the search for such documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 10 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, documents and things related to Respondent's alleged continued use of the Mark since its alleged first use date. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 11 requesting, *inter alia*, all documents concerning any third party's use of the Mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such documents are in the public domain, such

request is overly broad and unduly burdensome, the documents or information are not within the possession, custody or control of Respondent, the expense for the search for such documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 11 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, documents and things within Respondent's custody or control related to any third party use of the Mark. Although such information is not required to prove genericness of a mark, such information would be relevant in this case. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 12 requesting, *inter alia*, all documents concerning any third party's use of the term "comfortable" for FR wear, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such documents are in the public domain, such request is overly broad and unduly burdensome, the expense for the search for such documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 12 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, documents and things within Respondent's custody or control related to any third party use of the Mark. Although such information is not required to prove genericness of a mark, such information would be relevant in this case. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 13 requesting, *inter alia*, all documents concerning market research, product/service development and testing, and business plans concerning Respondent's Goods or Respondent's Mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such request is overly broad and unduly burdensome, the expense for the search for such documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Respondent further indicated that no documents will be produced in response to this request. This not surprising as Document Request No. 13 is highly relevant to the reasoning behind adopting the Mark and the manner in which the mark was used in advertising (i.e., the way it was perceived by the public). Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 13 nor all portions of any of such documents are privileged or protected by the work product doctrine. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request Nos. 14 and 15 requesting, *inter alia*, documents sufficient to identify total annual profits in dollars for each of Respondent's Goods offered under Respondent's Mark in the United States since the first distribution or provision thereof, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such documents are in the public domain, such requests are overly broad and unduly burdensome, the expense for the search for such documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Respondent has further indicated that no documents will be produced in response to this request. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request Nos. 14 and 15 nor all portions of any of such documents are privileged or protected by the work product doctrine. Also, such documents requested are focused on, *inter alia*, Respondent's profits from goods associated with the Mark which will be used to corroborate and weigh Respondent's assertions herein and/or elsewhere regarding the amount in controversy. Without such information, there is no way to substantively respond to

Respondent's objection regarding the burden/expense of responding to various interrogatories and requests as compared to the "amount in controversy". Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request Nos. 16 and 17 requesting, *inter alia*, samples of all actual or proposed marketing, advertisements, and promotional materials in which the Mark appears, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such documents are in the public domain, such requests are overly broad and unduly burdensome, the expense for the search for such documents outweighs the importance of such information, and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request Nos. 16 and 17 nor all portions of any of such documents are privileged or protected by the work product doctrine. Respondent is in the best position to know of and provide such information. The information requested is highly relevant as it involves examples of actual and proposed uses of Respondent's Mark which provide evidence on whether such use is a generic use of such terms for the specified goods/services. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 18 requesting, *inter alia*, all documents concerning, referring to, or relating to any dispute, including but not limited to written objections, threatened litigations, or legal proceedings, excluding the present proceeding, by or against Respondent or any other person involving, referring to, or relating to Respondent's Mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such documents are in the public domain, and the expense for the search for such documents outweighs the importance of such information. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 18 nor all portions of any of such documents are privileged or protected by the work product doctrine.

Respondent is in the best position to know of and provide such information and it should be easy to locate and provide such information if such information exists. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 19 requesting, *inter alia*, all documents concerning, referring to, or relating to any inquiry as to the connection, association and/or sponsorship among Respondent and Petitioner, Respondent's Marks and Petitioner's Marks, and/or Respondent's Goods and Petitioner's Goods, Respondent responded that such documents are privileged and/or protected by the work product doctrine, the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence, and such request is unduly broad and burdensome, and the expense for the search for such documents outweighs the importance of such information. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 19 nor all portions of any of such documents are privileged or protected by the work product doctrine. Respondent is in the best position to know of and provide such information and it should be easy to locate and provide such information if such information exists. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 20 requesting, *inter alia*, all documents concerning, referring to, or relating to any instance of confusion, mistake, and/or deception among Respondent's Mark and any third party's mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence, and such request is unduly broad and burdensome, and the expense for the search for such documents outweighs the importance of such information. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in Request No. 20 nor all portions of any of such documents are privileged or protected by the work product doctrine. Respondent is in the

best position to know of and provide such information and it should be easy to locate and provide such information if such information exists. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 21 requesting, *inter alia*, all documents concerning, referring to, or relating to the chain of title of Respondent's Mark, including, without limitation, assignments and other documents that affect title to Respondent's Mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, the expense for the search for such documents outweighs the importance of such information and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in request No. 21 nor all portions of any of such documents are privileged or protected by the work product doctrine. Respondent is in the best position to know of and provide such information and it should be easy to locate and provide such information if such information exists. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 22 requesting, *inter alia*, all documents concerning any license, permission, consent, authorization, or other grant of rights, whether oral or written, permitting any person to use Respondent's Mark or any other mark, Respondent responded that such documents are privileged and/or protected by the work product doctrine, the expense for the search of such documents outweighs the importance of such information and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in request No. 22 nor all portions of any such documents are privileged or protected by the work product doctrine. Respondent is in the best position to know of and provide such information and it should be easy to locate and provide such information if such information exists. Petitioner

requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 23 requesting, *inter alia*, all documents sufficient to identify prior and current outlets through which each of Respondent's Goods have been offered, provided, and/or planned for future sale in commerce, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such request is unduly broad and burdensome, the expense for the search of such documents outweighs the importance of such information and the documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither all such documents requested in request No. 23 nor all portions of any such documents are privileged or protected by the work product doctrine. Respondent is in the best position to know of and provide such information and it should be easy to locate and provide such information if such information exists. Although such information is not required to prove genericness of a mark, such information would be relevant in this case. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 24 requesting, *inter alia*, all reports, memoranda, correspondence, or other documents concerning the retention of experts for use in this action, Respondent responded that such documents are privileged and/or protected by the work product doctrine and that such request is premature in accordance with TMBP § 401.03.

In response to Document Request No. 25 requesting, *inter alia*, all reports, memoranda, correspondence, or other documents concerning the opinion or testimony of any expert retained or consulted by Respondent or by any person(s) acting for or on behalf of respondent in connection with this action, Respondent responded that such request was premature and that Respondent will disclose its expert in accordance with TMBP § 401.03.

In response to Document Request No. 26 requesting, *inter alia*, all documents concerning the concept of comfort vis-à-vis FR wear and the role comfort plays in buyer and user preference(s) for selecting or wearing particular wear garments, Respondent responded that such documents are privileged and/or protected by the work product doctrine and that such documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither such documents requested in request No. 26 nor all portions of any such documents are privileged or protected by the work product doctrine. Respondent is in the best position to know of and provide such information and it should be easy to locate and provide such information if such information exists. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 27 requesting, *inter alia*, all documents concerning Respondent's policy or procedure with respect to the retention or destruction of documents, Respondent responded that such documents are privileged and/or protected by the work product doctrine and that such documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither such documents requested in request No. 27 nor all portions of any such documents are privileged or protected by the work product doctrine. Respondent is in the best position to know of and provide such information and it should be easy to locate and provide such information if such information exists. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

In response to Document Request No. 28 request, *inter alia*, all documents other than those produced in response to any of the other Requests, upon which Respondent intends to rely in connection with the current proceeding, Respondent responded that such documents are privileged and/or protected by the work product doctrine, such documents are not relevant or reasonably calculated to lead to the discovery of admissible evidence and the expense for the

search of such documents outweighs the importance of such information. Petitioner has attempted to clarify its position(s) herein vis-à-vis the comments regarding Respondent's responses to the interrogatories and asserts that neither such documents requested in request No. 28 nor all portions of any such document are privileged or protected by the work product doctrine. Respondent is in the best position to know of and provide such information and it should be easy to locate and provide such information if such information exists. Petitioner requests that all such documents, samples, things, etc. be produced immediately or at least identified with the alleged reasoning for which such document or thing was not provided.

We look forward to a quick, complete, and non-evasive response.

If you have any questions, please give me a call at your earliest convenience.

Very truly yours,
LUEDEKA, NEELY & GRAHAM, P.C.

By: 
Michael E. Robinson

MER:MMG:nsw

cc: Michael J. Bradford, Esq. (*via Email*)
Matthew M. Googe, Esq. (*via Email*)
Denise Mroz, Esq. (*via Email*)

JACQUELINE LESSER
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January 26, 2012

VIA EMAIL:

Michael E. Robinson, Esq.
LUEDEKA, NEELY & GRAHAM, P.C.
P.O. Box 1871
Knoxville, TN 37901

**Re: Southern Mills, Inc. v. DriFire LLC
Cancellation No. 92054095**

Dear Mr. Robinson,

This responds to your letter of January 13th, regarding Respondent, DriFire LLC's responses to Petitioner's first set of discovery requests.

Your letter misleadingly suggests that DriFire has not substantively responded to these requests or set forth particularized objections to individual requests. As you are aware – DriFire has interposed specific objections to particular requests where required, pursuant to the Trademark Rules of Practice. Moreover, Respondent has made substantive responses to requests – to the extent that a request appeared to call in part for information which Respondent has not found objectionable, without waiver of noted objections.

The following responds to Petitioner's individual comments:

1. **Respondent's Interrogatory Responses.**

We note that Petitioner has not indicated a lack of formal responses to Interrogatory Requests Nos. 1, 2 and 4.

We are not certain of the bases Petitioner's objections to Respondent's responses to Interrogatory Requests Nos. 7 and 10. We believe that Respondent has responded substantively to these requests.

With respect to Interrogatory No. 5, you indicate that potential discovery of the separate terms "comfortable" and "FR wear" to be germane to a cancellation of the mark for the entire phrase COMFORTABLE FR WEAR. Please provide us with the legal basis for this argument, and how such discovery is relevant in an action claiming that a mark is generic.



Michael E. Robinson, Esq.
January 26, 2012
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With respect to DriFire's objection to Petitioner's Interrogatory No. 6, Respondent disagrees that the identity of Respondent's licensees is relevant to this proceeding, in particular given the highly confidential nature of the request, and Petitioner's representation that it is a competitor of the Respondent. It is sufficient in an action of this nature to provide information on the classes of customers and relevant public, as Respondent has done.

Petitioner's Interrogatory No. 16 seeks in detail information on the relationship of a number of companies which Respondent has not identified in its papers. As Respondent has advised in response to Interrogatory No. 7 that it, and no other entity, owns the subject mark, please advise of the relevancy of this request, or how a response to this request is likely to lead to discoverable information.

2. **Respondent's Responses to Petitioner's Document Requests.**

With regard to DriFire's responses to Petitioner's first document requests, with the exception of 7 of 28 document requests, Respondent has agreed to produce documents, to the extent that such are in existence, subject to specific objections, including the attorney-client privilege or the work-product doctrine. The requests as framed call for "*all documents, relating, referring or concerning...*," leading to Respondent's objections on the basis of the attorney-client privilege and work-product doctrine. An objection based on privilege or work product, where appropriate, will be interposed, regardless of whether there are any documents within the Respondent's possession, custody and control at the time of the request. However, to the extent that Respondent has in its possession, custody and control such production documents protected by attorney-client privilege or the work-product doctrine, a privilege log will be provided at a suitable time.

The document requests to which Respondent objects call for information not relevant to this proceeding, nor likely to lead to discovery of relevant and admissible information *and* which contain highly confidential information. Petitioner has claimed that it is a competitor of Respondent. There is no rationale for seeking customer information, financial information, nor prospective marketing plans in this cancellation proceeding.

Requests Nos. 13, 16, 17 and 26 seek highly confidential past and future marketing plans, and confidential consumer preference insight information without a showing that this information is relevant to this proceeding or likely to lead to discovery of relevant and admissible evidence.

Similarly, Petitioner seeks highly confidential financial and business information of Respondent, a competitor. (Document Requests Nos. 14 and 15). Petitioner's counsel states that these requests for the confidential financial information of a nonpublic company are important to be able to assess the "amount in controversy," an issue not relevant in a TTAB proceeding. These requests have no relevancy to the claims presented in this case and are not likely to lead to the discovery of relevant and admissible evidence. Likewise, Requests Nos. 22 and 23 seek confidential license agreements and customer information which are not relevant to this proceeding, and which need not be produced, as the identification of classes of customers is sufficient.



Michael E. Robinson, Esq.
January 26, 2012
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Requests 19 and 20 seek information on confusion, a claim not at issue in this cancellation proceeding. Such requests have been interposed merely to burden and harass Respondent. Petitioner has not offered any rationale for these requests.

We hope that this clarifies matters. We are available for further discussion.

Yours sincerely,

A handwritten signature in black ink that reads 'Jacqueline Lesser' in a cursive script.

Jacqueline Lesser

JL/jw

cc: Denise I. Mroz, Esq.
Charlie C. Lyu, Esq.

ANDREW S. NEELY
ROBERT O. FOX
DAVID E. LAROSE
GEOFFREY D. KRESSIN
AUGUST E. ROEHRIG, JR.
RICHARD W. BARNES, JR.
MARK P. CROCKETT
J. DAVID GONCE
MICHAEL J. BRADFORD
MICHAEL E. ROBINSON
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INTELLECTUAL PROPERTY MATTERS
PATENTS, TRADEMARKS,
TECHNOLOGY LICENSING, COPYRIGHTS,
AND RELATED LITIGATION

February 1, 2012
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Ms. Jacqueline Lesser, Esq.
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Via Email Followed By U. S. Mail

RE: Petition to Cancel COMFORTABLE FR WEAR, Reg. No. 3,915,295
Cancellation No. 92054095
LNG File No. 67071.99 / C-6664.0

Dear Ms. Lesser:

We are in receipt of your recent letter dated January 26, 2012, which regrettably provided no additional substantive information vis-à-vis Petitioner's First Set of Interrogatories and Petitioner's First Set of Requests for Documents and Things. If Respondent is intent on not providing any further information despite Petitioner's objections and further support therefor as set forth in our letter dated January 13, 2012, please simply give me a call or send an e-mail indicating such. This way, we can avoid any additional delay during the discovery period and move forward with a proper motion to compel.

If Respondent is open to providing reasonable responses, please consider the information provided below in response to your letter dated January 26, 2012.

1. Respondent's Interrogatory Responses

Petitioner re-asserts its comments and objections regarding Respondent's responses to all of Petitioner's Interrogatories.

Although you may believe Respondent's response to interrogatory No. 7 was "substantive", such response evades the question and is a self-serving statement that does not supply Petitioner with the information reasonably requested on that particular interrogatory (*i.e.*, the simple chain of title, if any). This is a very simple question and the answer should be equally straightforward and not ambiguous. The response, "Respondent is the sole and exclusive owner of the mark COMFORTABLE FR WEAR" does not address the issue of prior ownership information, if any, of the mark and goodwill, if any, associated with the mark. Respondent's response merely asserts a **current** alleged status of the mark and the alleged ownership thereof.

Interrogatory 5 speaks for itself. As Respondent's counsel is no doubt aware, this cancellation proceeding is based, *inter alia*, on the assertion that the mark COMFORTABLE FR WEAR is generic. Genericness is the ultimate in descriptiveness. *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 988, 228 USPQ 528, 530 (Fed. Cir. 1986). The use of (and the magnitude of use of) the term "comfortable" in close relationship with the term "FR wear" by Respondent and other third parties is highly relevant to how the relevant industry and relevant consumers as a whole describe and perceive FR wear for various brands. All relevant industry participants (and all clothing manufacturers generally) are in the business of making wearable clothing comfortable for a purchaser to wear while maintaining relevant desirable properties in the construction of such materials. *See, e.g.*, U.S. Pat. App. Pub. No. 2008/0040866, ¶ [0085] entitled "Textiles with High Water Release Rates and Methods for Making Same" ("the '866 Publication")¹ assigned to Optimer, Inc.—the apparent parent company of DriFire, LLC; and U.S. Pat. No. 5,888,914 entitled "Synthetic Fiber Fabrics with Enhanced Hydrophilicity and Comfort,"² also assigned to Optimer, Inc. There is no other word in the English language that connotes the same meaning as the term "comfortable" and such term in the clothing industry has a meaning which is understood and which can be quantitatively measured. See the '914 Patent, FIGS. 2 and 3. As such, uses of the term "comfortable" in association with the phrase "FR wear", even if not immediately adjacent to one another, are

¹ The '866 Publication states the following: "The treated fabrics of the present invention can be used for **any article of clothing**, including shirts, pants, and socks. Socks, for example, can be **uncomfortable** when perspiration creates a feeling of dampness. This condition can be exacerbated by wearing shoes with limited air circulation. *The present invention improves the comfort of the sock* by increasing the rate at which the sock will release perspiration to the surrounding environment. *In addition to the added comfort* resulting from a relatively dry foot, the present invention helps retard the growth of harmful bacteria, fungus, and other related foot conditions" (emphasis added).

² Title; Column 1, lines 12,18-21, 39-51, and 64-66; Column 2, Lines 8-12 (referring to two of only four figures in the '914 Patent); Column 3, line 29; Column 5, lines 45-50, 60-67; and Column 6, Lines 1-5, 8-17.

highly probative of demonstrating the well-understood nature of the term “comfortable” in the relevant industry and pointing to other evidence which would further demonstrate that the phrase “comfortable FR wear” is the ultimate in descriptiveness for the specific goods offered under Respondent’s mark. Simply put, those wishing to offer FR wear for sale would need to use, and are entitled to use, the generic term “comfortable” in connection with such goods (*i.e.*, FR wear).

Petitioner once again requests a comprehensive and substantive response to interrogatory 5 to avoid any further delay in this case.

With regard to Interrogatory No. 16, the position(s) taken by a third parties (including, in particular, a parent company or related company of Respondent) regarding the identification and nature of goods offered by Respondent is highly relevant because it demonstrates how the relevant industry and relevant public identify the goods offered by Respondent. For example, a subsidiary or related company of Respondent that makes actual materials used to make the clothing offered by Respondent might provide informational materials to the public to identify or describe the nature of the materials it manufactures using terminology that is generic for such materials. Therefore, whether the term “comfortable” when used to describe such materials or fabrics is generic is highly relevant to whether the entire phrase “comfortable FR wear” is generic as a whole.

Petitioner once again requests a comprehensive and substantive response to interrogatory 16 to avoid any further delay in this case.

2. Respondent’s Responses to Petitioner’s Document Requests

Petitioner re-asserts its comments and objections regarding Respondent’s responses to all of Petitioner’s Requests for Production of Documents and Things with the exception of Requests Nos. 14 and 15.

Please provide a specific time frame for when Petitioner can expect to have access to documents to be provided by Respondent and specifically when Petitioner can expect to see the privilege log mentioned in the letter dated January 26, 2012.

Respondent’s letter dated January 26, 2012, states that, “[t]here is no rationale for seeking customer information, financial information, nor prospective marketing plans in this cancellation proceeding.” Petitioner disagrees. One rationale among others includes the need to determine

which customers, if any, are licensed to use Respondent's mark or if such customers are using the phrase "customer FR wear" in a generic sense without any license from respondent. Another rationale is to obtain information on how Respondent has marketed and plans to market its goods under Respondent's mark because the manner of such use or plans for use are indicative of whether such mark is being used in a generic sense.

Petitioner once again requests a comprehensive and substantive response to requests seeking customer information and prospective marketing plans.

With regards to Requests Nos. 13, 16, 17, and 26, Petitioner respectfully asserts consumer preference insight information, although not as important as consumers' *understanding* of a phrase or term, is still nonetheless relevant to a case involving the issue of genericness and whether a mark is capable of distinguishing one party's goods from another party's goods because such information by its very nature is highly likely to lead to information demonstrating such consumers' *understanding* of the meaning of terms or phrases of interest. This is true based on the simple premise that, if a consumer cannot or otherwise does not understand an underlying critical parameter of a question or inquiry (*e.g.*, a class of a product), the consumer cannot respond to a question or inquiry regarding the consumer's preference of even an unidentified member of such class in a manner wherein the response has any utility with regard to the critical parameter (*e.g.*, the class of the product). For some products, rough surfaces are preferred based on the class of goods at issue (*e.g.*, brake pads); for other products, smooth surfaces are preferred (*e.g.*, solid oral medicaments). For *all* clothing to be worn, comfort is fundamentally preferred and desirable over the alternative—discomfort. An understanding of the meaning of such critical parameter is necessary to getting to any preference-related information. Therefore, to the extent that consumer preference information is found in a document or other thing in the possession, custody, or control of Respondent, it logically follows that there is a high likelihood that such consumer's *understanding of* underlying critical parameters (*e.g.*, "FR wear", a type of clothing) in such documents or things is also present or otherwise disclosed therein. Because evidence of the public's understanding of a term or phrase is part of the two-step process of determining genericness, documents or things containing information regarding consumer preferences are necessarily relevant to the issue of genericness. *H. Marvin Ginn Corp.*, 782 F.2d at 988, 228 USPQ at 530.

Petitioner once again requests a comprehensive and substantive response to requests 13, 16, 17 and 26 to avoid any further delay in this case.

Please disregard the specific portions of any request that mention the “amount in controversy.” The inclusion of this phrase was an inadvertent error. However, to the extent that documents and things contain information regarding any license agreements with customers or any third party, that information is relevant. A determination of which of Respondent’s customers, if any, are licensed to use Respondent’s mark or if such customers are using the phrase “customer FR wear” in a generic sense without any license from respondent is relevant to, *inter alia*, what the relevant industry understands the phrase “comfortable FR wear” to mean.

Petitioner once again requests a comprehensive and substantive response to requests 22 and 23 to avoid any further delay in this case.

Respondent’s counsel’s comments regarding requests 19 and 20 are incorrect and are not well taken. The issue of consumer confusion is highly relevant to whether a term or phrase is generic for a particular class of goods. Because a generic mark cannot function as an indication of source, evidence of any confusion between Respondent’s mark and any third party’s mark might be relevant to show that consumers do not understand Respondent’s mark to be an indication of source but instead as a description of protective apparel generally. See, e.g., *Bellsouth Corp v. Datational Corp.*, 60 F.3d 1565, 1569 (Fed. Cir. 1995) (holding that a generic term, unlike a trademark, describes a product generally and “cannot inform the public that the product has a particular source”). If the relevant public is confused as to the source of a particular good based on the marking of such good, this evidence logically points to a conclusion that such marking might be a generic term or phrase in the industry which would naturally cause confusion among the consuming public.

Petitioner is not attempting to harass Respondent. Nonetheless, Petitioner felt considerably harassed when it received a cease and desist letter dated April 28, 2010, from your firm on behalf of Respondent alleging that Petitioner was using marketing materials that infringed Respondent’s mark (which, at that time, had not even become registered on the Supplemental Register). To now suggest that Petitioner is attempting to harass Respondent by requesting information regarding any public confusion—the very subject that initiated this entire

situation—is simply not an acceptable or reasonable response by Respondent or its counsel. Simply put, you are no doubt aware that consumer confusion is relevant to two general issues including (1) trademark infringement (not at issue here) AND (2) whether a mark used by one party is capable of distinguishing such party's goods over goods of the same class offered by others (precisely the issue here).

Petitioner once again requests a comprehensive and substantive response to requests 19 and 20 to avoid any further delay in this case.

Again, we look forward to a quick, complete, and non-evasive response in order to avoid the need to move to compel this information.

If you have any questions, please give me a call at your earliest convenience. Again, if Respondent is unwilling to provide any further information, responses, documents, and/or things, please let us know at your earliest convenience.

Very truly yours,
LUEDEKA, NEELY & GRAHAM, P.C.

By: 
Michael E. Robinson

MER:MMG:nsw

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Via Email Followed By U. S. Mail

RE: Petition to Cancel COMFORTABLE FR WEAR, Reg. No. 3,915,295
Cancellation No. 92054095
LNG File No. 67071.99 / C-6664.0

Dear Ms. Lesser:

This letter is to summarize some of the issues discussed during our phone conference last week.

The parties have agreed to a two-month extension and we note that an order was granted earlier this week allowing for that extension. Thank you for taking care of filing the request. Along the same lines, our client requests a 30-day extension to respond to the discovery propounded by your client that is coming due soon. The extra time will allow our client to consider the documents and answers provided by your client as well as documents provided by third parties under various subpoenas *duces tecum*. Also, as DriFire is aware, this is a busy season for marketing and trade shows. As such, much of the marketing department at Southern Mills is very busy with those efforts right now and they have less time to devote to thoroughly answering DriFire's discovery requests. Please advise if a 30-day extension is acceptable to your client. As you will recall, a one-month extension for your client was previously agreed to by our client vis-à-vis our client's propounded discovery requests.

We are in receipt of the documents you mentioned during the phone conference that were in transit. Thank you for providing these documents.

At your earliest convenience, please let us know who you expect to be present to act as the 30(b)(6) witness(es) at the deposition noticed in our recent Notice of Deposition to DriFire. Also, please let us know when you expect to have a privilege log available for us to review regarding any documents and things that were not included in those that were sent to us.

I. Issues of Concern

During our discussion with regards to interrogatory number 16, you noted that OPTIMER, INC. (“Optimer”) is not the parent company of DriFire, LLC. You indicated that Optimer is in a licensing relationship of some kind with DriFire. We reminded you that Optimer was first disclosed to us in DriFire’s initial disclosures. We also noted during the phone conference that parties in a TTAB action are required to respond to interrogatories to the extent such interrogatories are not properly objected to. You indicated that such rule is permissive and included the term “may,” not “must.” However, TBMP § 405.04(b), citing FRCP Rule 33(b)(3), states that “[e]ach interrogatory *must*, to the extent it is not objected to, be answered separately and fully in writing under oath” (emphasis added). Accordingly, please at least provide a substantive response concerning DriFire’s relationship with Optimer, Inc. and Optimer Performance Fibers, Inc. as soon as possible.

You also argued that license agreements and related information are not relevant to this case (*e.g.*, Request No. 22). However, TBMP § 414(10) states that “[i]nformation concerning litigation controversies including settlement and other contractual agreements made between a responding party and third parties based on the responding party's mark is discoverable.” *See, e.g., Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975) (“[I]nformation pertaining to opposer's contacts with third parties, as through litigation or written or oral agreements, based on opposer's pleaded mark “BAND-AID” for the goods shown in the registration thereof may have some relevance herein, inasmuch as it might tend to show limitations on opposer's rights or inconsistencies with opposer's statements in this proceeding, and that interrogatories seeking such information should accordingly be answered.”). For this and many other reasons, licensing agreements and the specific nature of the relationship between DriFire and any of the parties mentioned in Interrogatory No. 16 is relevant and should be

produced, and any documents and things under Request No. 22 are relevant and should be produced.

We respectfully assert that it is not Petitioner's counsel's job to prove to Respondent's counsel why certain interrogatories and requests propounded by Petitioner for documents and things should be substantively responded to by Respondent. Such a requirement would create an atmosphere in which modern discovery tools would be rendered virtually meaningless for the propounding party. The burden here is on Respondent to demonstrate a reasonable basis for its objections to any interrogatories or requests to produce documents and things. Therefore, Petitioner respectfully requests that Respondent fully respond to any and all remaining interrogatories and requests.

II. Issues for Clarification

A. Petitioner's Interrogatories

Regarding Interrogatory No. 3, Petitioner is entitled to know (and Respondent is required to demonstrate) the identity of Respondent's first customer of goods that were sold using the Mark and the factual circumstances of such first sale in order to verify Respondent's alleged first use date. This is a well known exception to the confidential nature of customer lists generally. See TBMP § 414(3); *Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (stating "a party is usually required to furnish the name and address of its first customer in order to verify its claimed date of first use"). This interrogatory is re-asserted one final time.

Regarding Interrogatory No. 5, the way in which Respondent has used the term "comfortable" and the term "FR wear", and the context of how these terms have been used together and alone is highly significant to a determination of whether the phrase "comfortable FR wear" is generic and has been used in a generic sense by Respondent for the goods provided by Respondent. To the extent necessary, one or more representative lists could be used so long as such list is representative of all uses of the term "comfortable" with respect to the goods offered in conjunction with the Mark by Respondent or Respondent's licensee(s). This interrogatory is re-asserted one final time.

Regarding Interrogatory No. 6, the identity and description of "agreements, assignments, licenses, consents, distributorship arrangements and/or any other contracts or understandings of

any kind between Respondent and any other person relating to and/or referring to Respondent's Mark" is highly relevant. This issue is well-settled as discussed above. *Johnson & Johnson*, 186 USPQ 167. This interrogatory is re-asserted one final time.

Regarding Interrogatory No. 8 and the answer Respondent's counsel has supplied to date, we are made to understand that no searches or investigations were conducted for or relating to Respondent's Mark, and no opinion was provided by or on behalf of Respondent.

Regarding Interrogatory No. 10, please clarify whether Respondent *has ever been* involved in any disputes relating to Respondent's Mark other than the current dispute. This aspect of this interrogatory was not addressed in your previous response. This interrogatory is re-asserted one final time.

Interrogatory No. 15 is hereby revised as follows: "Identify and describe the complete bases upon which Respondent is relying to assert that the phrase 'comfortable FR wear' is capable of distinguishing Respondent's Goods and is not generic to such goods." The term "assert" as used herein in lieu of "claim" is defined using its normal dictionary definition. The basis of the assertion is Respondent's application to register the phrase "comfortable FR wear," wherein Rob Hines signed a declaration under potential penalty of perjury (*i.e.*, "asserting" or "declaring") that DriFire, LLC allegedly has the exclusive right to use such phrase as a source indicator for the goods listed in such application. This interrogatory is re-asserted one final time.

Interrogatory No. 16 is hereby revised as follows: Identify and describe in detail the relationship(s), if any, between DRIFIRE, LLC; OPTIMER, INC.; and OPTIMER PERFORMANCE FIBERS, INC. During our phone conference, you indicated that a licensing relationship exists between DriFire, LLC and Optimer, Inc. and/or Optimer Performance Fibers, Inc. The issue regarding the relevance as to such information is well-settled as discussed above. *Johnson & Johnson*, 186 USPQ 167. This interrogatory is re-asserted one final time.

B. Petitioner's Requests for Documents and Things

Request No. 13 is hereby revised as follows: "All documents concerning market research, product/service development and testing, and business plans concerning Respondent's Respondent's Mark, including without limitation, marketing plans, media plans, sales plans, sales materials, distribution plans and advertising campaigns." This request is focused solely on

Respondent's planned uses for the phrase "comfortable FR wear." This request is re-asserted one final time.

As discussed during the phone conference last week, Petitioner withdraws document requests numbers 14 and 15.

Regarding Request Nos. 19 and 20, evidence of confusion is highly relevant to this case because generic phrases are the most likely of any type of phrase to cause customer confusion. As Respondent's counsel is surely aware, this is true because generic phrases are incapable of operating as a source identifier for goods or services. Thus, such information is very relevant and is likely to lead to other admissible evidence. This request is not overly broad. It is direct and clear. Respondent either has such information or it does not. If Respondent has no such documents and things, please provide a clear response stating such. If Respondent does have such documents and things, Respondent is urged to produce such documents and things immediately. As Respondent's counsel is aware, to the extent any attorney opinion is included in such documentation, such information can be redacted. There is simply no reasonable basis for refusing to provide this information unless no such information exists, in which case Respondent must provide a clear answer stating such to the best of its knowledge. This request is re-asserted one final time.

The benefits to the disclosure of documents and things in response to Request No. 23 outweigh any perceived harm to Respondent because such information will provide direct evidence of the identity of the customers that purchase Respondent's goods, thereby helping to define the purchasing public for this case. This request is re-asserted one final time.

Request No. 26 is hereby revised as follows: "All documents concerning customers' or potential customers' understanding of the meaning of the term 'comfort,' 'comfortable', and 'comfortable FR wear'". This request is re-asserted one final time.

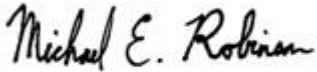
Again, we look forward to a quick, complete, and non-evasive response in order to avoid the need to move to compel this information.

If you have any questions, please give me a call at your earliest convenience. Again, if Respondent is unwilling to provide any further information, responses, documents, and/or things, please let us know at your earliest convenience.

February 17, 2012
Cancellation No. 92054095

Very truly yours,

LUEDEKA NEELY GROUP, P.C.

By: 
Michael E. Robinson

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